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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Lee Anne Kowalski

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04/25/2006

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EXAMINER

HUTTON JR, WILLIAM D

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/928,599

Applicant(s)

KOWALSKI, LEE ANNE

Examiner

Doug Hutton

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Applicant's Response***

In Applicant's Response dated 02/27/2006, Applicant submitted two 131 declarations, amended Claims 1-7, 23-29 and 45-51, and argued against all rejections previously set forth in the Office Action dated 11/29/2005.

Based on the amendments to Claims 2-7, 24-29 and 46-51, the rejections previously set forth are withdrawn.

***131 Declaration***

The 131 declarations filed on 02/27/2006 under 37 CFR 1.131 have been considered but are ineffective to overcome the Padwick and Rand references, as indicated in the following discussion.

Firstly, affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor of the subject matter of the rejected claims, a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor.

Under the present circumstances, the sole inventor is available and cooperative (see 37 CFR 1.47) and is neither dead (see 37 CFR 1.42) nor insane (see 37 CFR 1.43). Thus, the 131 declaration signed by Applicant's legal representative is not eligible for consideration by the examiner.

Secondly, the evidence submitted is insufficient to establish due diligence from a date prior to the date of reduction to practice of the Padwick and Rand references to either a constructive reduction to practice or an actual reduction to practice.

Lee Anne Kowalski, the sole inventor of the present application, signed a 131 declaration submitted with Applicant's response. The declaration indicates that the invention was conceived (see Statement 2a) before June 21, 2000 and reduced to practice on a continuous basis from that time to the filing of the present application (see Statement 3). Thus, the declaration attempts to establish **conception** of the invention prior to the effective date of the reference coupled with **due diligence** from prior to the reference date to the filing date of the application (constructive reduction to practice).

The declaration and the exhibits appear to sufficiently demonstrate that the invention was **conceived** prior to June 21, 2000. However, the declaration fails to sufficiently demonstrate **due diligence** from prior to the reference date to the filing date of the application, as indicated in the following discussion.

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966).

The 131 declaration signed by the Inventor states that, during the time period between an unspecified date (the date that the present invention was "rated," sometime before June 21, 2000) and May 8, 2001 (the date that the IBM Intellectual Property Law Department made a "final" decision to file a patent application for the present invention), a patentability search and a "filing determination" were conducted (see Statement 3d). The declaration gives no details about **how long** the patentability search took or **what**

was searched. The declaration also gives no details about the **steps involved** in the “filing determination” or **how long** the “filing determination” took. Thus, in 323 days (the time period between June 20, 2000 and May 8, 2001), a patentability search and a “filing determination” were conducted. This is insufficient proof of due diligence.

Moreover, the declaration and the exhibits fail to show that the invention actually **existed** and **worked for its intended purpose**. The declaration fails to point out **where** each limitation of the claims is proven to exist and work for its intended purpose in the exhibits. In other words, the declaration fails to map the recited claim limitations to those portions of the exhibits that demonstrate the invention existed and worked for its intended purpose.

The declaration states that the “Disclosure” document (i.e., one of the exhibits) describes the invention and fully supports the claims (see Statement 2b). However, that statement fails to point out **how** the “Disclosure” document **proves** that each limitation of the claimed invention **existed** and **worked for its intended purpose**. Stated differently, Statement 2b fails to demonstrate which parts of the “Disclosure” document prove that each limitation of the claimed invention existed and worked for its intended purpose. Additionally, the declaration **fails** to mention any details regarding the **development** of the software and the **testing** of the software to ensure that it worked for its intended purpose.

The declaration and exhibits must clearly explain which facts or data Applicant is relying on to show completion of her invention prior to the particular date. Each exhibit relied upon should be specifically referred to in the declaration, in terms of what it is

relied upon to show. Vague and general statements in broad terms about what the exhibits describe (see Statement 2b) along with a general assertion that the exhibits describe a reduction to practice “amounts essentially to mere pleading, unsupported by proof or a showing of facts” and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974).

Applicant may correct this deficiency by giving a clear explanation of how the exhibits prove that the claimed invention actually existed and worked for its intended purpose.

### ***Claim Objections***

Claims 4-7, 26-29 and 48-51 are objected to because of the following informalities:

- in Claim 4, the phrase “*profile **when the electronic message is altered when received***” in Line 2 should be amended to — profile, ~~when~~ wherein the electronic message is altered when received — so that it clearly indicates when the electronic message is altered. Claims 26 and 48 have the same problem.
- in Claim 5, the phrase “*profile **when the electronic message is altered when authored***” in Line 2 should be amended to — profile, ~~when~~ wherein the electronic message is altered when authored — so that it clearly indicates when the electronic message is altered. Claims 27 and 49 have the same problem.

- in Claim 6, the phrase “*profile **when the electronic message is altered when received***” in Lines 2-3 should be amended to — profile, ~~when~~ wherein the electronic message is altered when received — so that it clearly indicates when the electronic message is altered. Claims 28 and 50 have the same problem.
- in Claim 7, the phrase “*profile **when the electronic message is altered when authored***” in Lines 2-3 should be amended to — profile, ~~when~~ wherein the electronic message is altered when authored — so that it clearly indicates when the electronic message is altered. Claims 29 and 51 have the same problem.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 8-16, 19-23, 30-38, 41-45, 52-60 and 63-66 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Padwick, Gordon, **Special Edition Using Microsoft Outlook 2002** (Que Publishing, 1 May 2001), in view of Rand et al., U.S. Patent Application Publication No. US 2004/0080528 A1.

*Claim 1:*

Padwick discloses a computer-implemented method for identifying and distinguishing words contained within an electronic message (see Chapter 28 – Creating and Using Rules, “*Using the Rules Wizard to Manage Incoming Messages*” Pages 1-16 of 16 – Padwick discloses this limitation in that Outlook includes an “Rules Wizard” tool that allows the user to search emails for a particular term or phrase), comprising the steps of:

- comparing, in a computer, message terms in an electronic message to significant terms stored by the computer in an online registry to identify any of the message terms in the electronic message that match the significant terms stored in the online registry (see Figure 28.7; see Pages 1-11 of 16 – Padwick discloses this limitation in that the “Rules Wizard” tool allows the user to create rules to filter emails based on whether user-specified terms are in the emails. Every rule created is stored on the computer, so that the rules may be subsequently applied to emails. Thus, the user-specified terms are “stored” by an “online registry.”); and
- identifying, in the computer, the matched message terms and indicating their significance to a reader by sending electronic messages that include any matched significant message terms to a folder (see Figure 28.8; see Pages 1-11 of 16 – Padwick discloses this limitation in that the “Rules Wizard” tool allows the user to specify that emails satisfying a rule are moved to a particular folder. By moving emails that include user-specified terms to a particular folder, Padwick



“identifies the matched message terms” and “indicates their significance to a reader.”).

Padwick fails to expressly disclose:

- *making*, in the computer, *alterations* within the electronic message itself to identify the matched message terms and to indicate their significance to a reader.

Rand teaches a computer-implemented method for identifying and distinguishing words contained within an electronic message (see Figures 1 and 3; see Paragraphs 0015 and 0049 – Rand teaches this limitation in that the electronic document display system includes an “Keyword Search” tool that allows the user to search documents for a particular term or phrase), comprising the steps of:

- comparing, in a computer, message terms in an electronic message to significant terms to identify any of the message terms in the electronic message that match the significant terms (see Figure 3; see Paragraph 0049 – Rand teaches this limitation in that the electronic document display system includes a “search” function, which generates a list of documents that include user-specified search terms); and
- making, in the computer, alterations within the electronic message itself to identify the matched message terms and to indicate their significance to a reader (see Paragraph 0049 – Rand teaches this limitation in that the electronic document display system allows the user to click on any of the documents in the

list and, upon selection of a listed document by the user, displays the document with the highlighted search term. By highlighting the search terms, Rand “identifies” the matched message terms by “making alterations in the electronic message itself” and “indicates their significance.”), for the purpose of calling the user’s attention to the search terms and clearly indicating the location of the search terms in the document to the user.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of:

- making, in the computer, alterations within the electronic message itself to identify the matched message terms and to indicate their significance to a reader, for the purpose of calling the user’s attention to the search terms and clearly indicating the location of the search terms in the document to the user, as taught in Rand.

*Claim 8:*

Padwick discloses collecting and storing significant terms in the online registry (see Chapter 28 – Creating and Using Rule; “*Using the Rules Wizard to Manage Incoming Messages*” and “*Creating Rules for Outgoing Messages*” – Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create

and save rules for searching incoming or outgoing emails for particular terms; thus, the rules constitute an “online registry” of “significant terms”).

*Claim 9:*

Padwick discloses a user selecting significant terms (Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create and save rules for searching incoming or outgoing emails for particular terms; thus, the user “selects significant terms”).

*Claim 10:*

Padwick discloses importing significant terms (see Chapter 28 – Creating and Using Rule; “*Managing Rules*” – Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file).

*Claim 11:*

Padwick discloses significant terms that are imported from an address book (Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file; a “file” includes an address book).

*Claim 12:*

Padwick discloses significant terms that are imported from a database (Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file; a “file” includes a database).

*Claim 13:*

Padwick discloses significant terms that comprise names of people, product terms or key words in a user’s field (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms, which may include “names of people”; for example, see Figure 28.4).

*Claims 14-16:*

Padwick, in view of Rand, fails to expressly disclose:

- making alterations to the electronic message comprises making the matched message terms a different color, a different font effect, or a different font type.

However, selecting a particular color, font effect, or font type for displaying the located search terms was a design choice that was well-known by one of ordinary skill in the art at the time the invention was made. Rand expressly taught “highlighting” the located search terms, but did not disclose the particular color in which the term is highlighted and whether the color, font effect, and/or font type could be changed by the user.

Changing the font effect, font type, and/or color of text in an electronic document was well-known at the time the invention was made by even ordinary computer users. At the

time the invention was made, those of ordinary skill in the art – computer programmers – would have known how to design a search tool so a user could select the particular color, font effect, and/or font type in which the located search term was displayed for the purpose of aesthetics.

Additionally, Padwick disclosed a Rules Wizard that allowed the user to compose multiple processing rules that are applied to each sent email. Thus, two rules could have been written to locate two different search requests for sent emails and display each located term in different colors, font effects, and/or font types, for the purpose of distinguishing the different search requests within each email.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include making alterations to the electronic message comprises making the matched message terms a different color, a different font effect, or a different font type, for the purposes of aesthetics and distinguishing the different search requests within each email.

*Claim 19:*

Padwick discloses identifying where the alterations to the matched message terms, taught by Rand, are to be performed according to a user setting (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms; thus, making the search term “distinct” is performed “according to a user setting”).

*Claim 20:*

Padwick discloses significant terms that are categorized and the user setting is based upon a category of the significant term (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms and process email messages containing each different search term in a particular way; for example, Outlook can search for all emails that include the term "deadline" and send those emails to a certain folder, or Outlook can search for all emails that include the term "office party" and delete those emails; thus, the significant terms are "categorized" and the user setting processes emails having the significant terms "based on a category of the significant term").

*Claim 21:*

Padwick fails to expressly disclose displaying the electronic message if the end of the electronic messages as been reached.

Rand teaches a method for identifying and distinguishing words contained within an electronic message (see Figures 1 and 3; see Paragraphs 0015 and 0049 – Rand teaches this limitation in that the electronic document display system includes an "Keyword Search" tool that allows the user to search documents for a particular term or phrase), comprising the step of:

- displaying the electronic message if the end of the electronic messages as been reached (see Paragraph 0049 – Rand teaches this limitation in that the electronic document display system allows the user to click on any of the documents in the list and, upon selection of a listed document by the user, displays the document with the highlighted search term; thus, the electronic document processing system has scanned the document for the significant term and displays the document “if the end of the electronic messages as been reached”),  
for the purpose of indicating the location of the search terms in the document to the user.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of displaying the electronic message if the end of the electronic messages as been reached for the purpose of indicating the location of the search terms in the document to the user, as taught in Rand.

*Claim 22:*

Padwick fails to expressly disclose querying a user before making alterations to the electronic message.

Rand teaches a method for identifying and distinguishing words contained within an electronic message (see Figures 1 and 3; see Paragraphs 0015 and 0049 – Rand teaches this limitation in that the electronic document display system includes an “Keyword Search” tool that allows the user to search documents for a particular term or phrase), comprising the step of:

- querying a user before making alterations to the electronic message (see Figures 1 and 3; see Paragraphs 0015 and 0049 – Rand teaches this limitation in that the electronic document display system allows the user to search the document for particular terms and distinctly displays those terms; thus, the electronic document processing system “queries the user before making alterations to the electronic message”),

for the purpose of indicating the location of the search terms in the document to the user.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of querying a user before making alterations to the electronic message, for the purpose of indicating the location of the search terms in the document to the user, as taught in Rand.



*Claims 23, 30-38 and 41-44:*

These claims merely recite an apparatus for performing the method of Claims 1, 8-16 and 19-22. Padwick discloses an "electronic message processor" (Claim 23, Line 3) and Rand teaches an "electronic message editor" (Claim 23, Line 6).

Thus, Claims 23, 30-38 and 41-44 are rejected using the same rationale used in the above rejections for Claims 1, 8-16 and 19-22, respectively.

*Claims 45, 52-60 and 63-66:*

These claims merely recite computer software for performing the method of Claims 1, 8-16 and 19-22. Both Padwick and Rand operate via computer software.

Thus, Claims 45, 52-60 and 63-66 are rejected using the same rationale used in the above rejections for Claims 1, 8-16 and 19-22, respectively.

Claims 2-7, 24-29 and 46-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padwick, in view of Rand, and further in view of Chen et al., U.S. Patent No. 6,009,442.

*Claim 2:*

As indicated in the above rejection, Padwick, in view of Rand, discloses/teaches every limitation of Claim 1.

Padwick, in view of Rand, fails to expressly disclose/teach an electronic message that is altered when authored.

Chen teaches a method for identifying and distinguishing words contained within an electronic message (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), comprising the step of:

- altering the electronic message when authored (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches “altering the electronic message when authored.”);
- for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of

Rand, to include the step of altering the electronic message when authored, for the purpose of calling the user's attention to the user-specified keywords, as taught in Chen.

*Claim 3:*

Padwick, in view of Rand, fails to expressly disclose/teach an electronic message that is altered when received.

Chen teaches a method for identifying and distinguishing words contained within an electronic message (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), comprising the step of:

- altering the electronic message when received (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify

keywords for both authored emails and received emails. Thus, Chen teaches “altering the electronic message when received.”);  
for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include the step of altering the electronic message when received, for the purpose of calling the user’s attention to the user-specified keywords, as taught in Chen.

*Claim 4:*

Padwick discloses significant terms that are determined based upon a reader profile (see Chapter 28 – Creating and Using Rules; “*Using the Rules Wizard to Manage Incoming Messages*” and “*Creating Rules for Outgoing Messages*” – Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create rules for processing incoming emails for the “reader”; these rules comprise the “reader profile” that determines the “significant terms”).

Padwick, in view of Rand, fails to expressly disclose/teach an electronic message that is altered when received.

Chen teaches a method for identifying and distinguishing words contained within an electronic message (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), comprising the step of:

- altering the electronic message when received (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches “altering the electronic message when received.”);

for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include the step of altering the electronic message when received, for the purpose of calling the user’s attention to the user-specified keywords, as taught in Chen.

*Claim 5:*

Padwick discloses significant terms that are determined based upon a author profile (Padwick discloses this limitation in that Outlook includes a "Rules Wizard" that allows the user to create rules for processing outgoing emails for the "author"; these rules comprise the "author profile" that determines the "significant terms").

Padwick, in view of Rand, fails to expressly disclose/teach an electronic message that is altered when authored.

Chen teaches a method for identifying and distinguishing words contained within an electronic message (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), comprising the step of:

- altering the electronic message when authored (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify

keywords for both authored emails and received emails. Thus, Chen teaches “altering the electronic message when authored.”); for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include the step of altering the electronic message when authored, for the purpose of calling the user’s attention to the user-specified keywords, as taught in Chen.

*Claim 6:*

Padwick, in view of Rand, fails to expressly disclose/teach:

- matched message terms that are identified based upon a reader profile, wherein the electronic message is altered when received.

Chen teaches a method for identifying and distinguishing words contained within an electronic message (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), comprising the step of:

- matched message terms that are identified based upon a reader profile, wherein the electronic message is altered when received (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches “matched message terms that are identified based upon a reader profile” and “altering the electronic message when received.”),

for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include the step of:

- matched message terms that are identified based upon a reader profile, wherein the electronic message is altered when received,

for the purpose of calling the user’s attention to the user-specified keywords, as taught in Chen.



*Claim 7:*

Padwick, in view of Rand, fails to expressly disclose/teach:

- matched message terms that are identified based upon a author profile, wherein the electronic message is altered when authored.

Chen teaches a method for identifying and distinguishing words contained within an electronic message (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), comprising the step of:

- matched message terms that are identified based upon a author profile, wherein the electronic message is altered when authored (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches “matched message terms that are identified based upon an author profile” and “altering the electronic message when authored.”);

for the purpose of calling the user's attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include the step of:

- matched message terms that are identified based upon a author profile, wherein the electronic message is altered when authored,

for the purpose of calling the user's attention to the user-specified keywords, as taught in Chen.

*Claims 24-29:*

These claims merely recite an apparatus for performing the method of Claims 2-7. Padwick discloses an "electronic message processor" (Claim 23, Line 3), Rand teaches an "electronic message editor" (Claim 23, Line 6) and Chen teaches a computer apparatus (see Figure 1A).

Thus, Claims 24-29 are rejected using the same rationale used in the above rejections for Claims 2-7, respectively.

*Claims 46-51:*

These claims merely recite computer software for performing the method of Claims 2-7. Padwick, Rand and Chen operate via computer software.

Thus, Claims 46-51 are rejected using the same rationale used in the above rejections for Claims 2-7, respectively.

Claims 17, 18, 39, 40, 61 and 62 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Padwick, in view of Rand, and further in view of Abu-Hakima et al., U.S. Patent Application Publication No. US 2003/0020749 A1.

*Claim 17:*

As indicated in the above rejection, Padwick, in view of Rand, discloses/teaches every limitation of Claim 1.

Padwick, in view of Rand, fails to expressly disclose/teach:

- inserting an object into the electronic message near the matched message term.

Abu-Hakima teaches a method for identifying and distinguishing words contained within an electronic message (see Paragraphs 0001 and 0006-0008 – Abu-Hakima teaches this limitation in that the electronic document processor searches for concepts and displays those concepts), comprising the steps of:

- inserting an object into the electronic message near the matched message term (see Figure 4; see Paragraph 0067 – Abu-Hakima teaches this limitation in that the electronic document processor displays the concept within an icon),

for the purpose of calling the user's attention to the message in which the matched significant message term is located.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include inserting an object into the electronic message near the matched message term, for the purpose of calling the user's attention to the message in which the matched significant message term is located, as taught by Abu-Hakima.

*Claim 18:*

Padwick, in view of Rand, fails to expressly disclose/teach:

- an object that comprises an image, a sound file, an icon, a link or a video.

Abu-Hakima teaches a method for identifying and distinguishing words contained within an electronic message (see Paragraphs 0001 and 0006-0008 – Abu-Hakima teaches this limitation in that the electronic document processor searches for concepts and displays those concepts), comprising the steps of:

- selecting an object that comprises an image, a sound file, an icon, a link or a video (see Figure 4; see Paragraph 0067 – Abu-Hakima teaches this limitation in that the electronic document processor displays the concept within an icon),

for the purpose of calling the user's attention to the message in which the matched significant message term is located.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include selecting an object from the group consisting of an image, a sound file, an icon, a link and a video for the purpose of calling the user's attention to the message in which the matched significant message term is located, as taught by Abu-Hakima.

*Claims 39 and 40:*

These claims merely recite an apparatus for performing the method of Claims 17 and 18. Padwick discloses an "electronic message processor" (Claim 23, Line 3), Rand teaches an "electronic message editor" (Claim 23, Line 6) and Abu-Hakima teaches "system architectures" (see Paragraph 0001).

Thus, Claims 39 and 40 are rejected using the same rationale used in the above rejections for Claims 17 and 18, respectively.

*Claims 61 and 62:*

These claims merely recite computer software for performing the method of Claims 17 and 18. Padwick, Rand and Abu-Hakima operate via computer software.

Thus, Claims 61 and 62 are rejected using the same rationale used in the above rejections for Claims 17 and 18, respectively.

Claims 1-16, 19-38, 41-60 and 63-66 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Padwick, in view of Chen.

*Claim 1:*

Padwick discloses *a computer-implemented method for identifying and distinguishing words contained within an electronic message* (see Chapter 22 – Creating and Using Rules, “Using the Rules Wizard to Create Rules that Manage Incoming Messages” Pages 1-19 of 19 – Padwick discloses this limitation in that Outlook includes an “Rules Wizard” tool that allows the user to search emails for a particular term or phrase), *comprising the steps of:*

- *comparing, in a computer, message terms in an electronic message to significant terms stored by the computer in an online registry to identify any of the message terms in the electronic message that match the significant terms stored in the online registry* (see Pages 1-19 of 19 – Padwick discloses this limitation in that the “Rules Wizard” tool allows the user to create rules to filter emails based on whether user-specified terms are in the emails. Every rule created is stored on the computer, so that the rules may be subsequently applied to emails. Thus, the user-specified terms are “stored” by an “online registry.”); *and*

- *identifying, in the computer, the matched message terms and indicating their significance to a reader by sending electronic messages that include any matched significant message terms to a folder* (see Pages 1-19 of 19 – Padwick discloses this limitation in that the “Rules Wizard” tool allows the user to specify that emails satisfying a rule are moved to a particular folder. By moving emails that include user-specified terms to a particular folder, Padwick “identifies the matched message terms” and “indicates their significance to a reader.”).

Padwick fails to expressly disclose:

- *making, in the computer, alterations within the electronic message itself to identify the matched message terms and to indicate their significance to a reader.*

Chen teaches *a computer-implemented method for identifying and distinguishing words contained within an electronic message* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising the step of:*

- *making, in the computer, alterations within the electronic message itself to identify the matched message terms and to indicate their significance to a reader* (see Figure 1B; see Column 3, Line 37 through Column 4, Line 5; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column

8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. When a user-specified keyword is detected in an email, the system designates the email for storage in a user-specified folder. In this way, the system “alters the email itself.” Subsequently, when the email is viewed by the user, the system highlights the user-specified keyword. By highlighting the user-specified keywords, Chen “identifies matched message terms” and “indicates their significance to a reader.”),  
for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of:

- *making, in the computer, alterations within the electronic message itself to identify the matched message terms and to indicate their significance to a reader,*  
for the purpose of calling the user’s attention to the user-specified keywords, as taught in Chen.



*Claim 2:*

Padwick fails to expressly disclose an electronic message that is altered when authored.

Chen teaches a method for identifying and distinguishing words contained within an electronic message (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), comprising the step of:

- altering the electronic message when authored (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches “altering the electronic message when authored.”);

for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of altering the electronic message when authored, for the purpose of calling the user's attention to the user-specified keywords, as taught in Chen.

*Claim 3:*

Padwick fails to expressly disclose an electronic message that is altered when received.

Chen teaches a method for identifying and distinguishing words contained within an electronic message (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), comprising the step of:

- altering the electronic message when received (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-

specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches “altering the electronic message when received.”); for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of altering the electronic message when received, for the purpose of calling the user’s attention to the user-specified keywords, as taught in Chen.

*Claim 4:*

Padwick discloses significant terms that are determined based upon a reader profile (see Chapter 28 – Creating and Using Rules; “*Using the Rules Wizard to Manage Incoming Messages*” and “*Creating Rules for Outgoing Messages*” – Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create rules for processing incoming emails for the “reader”; these rules comprise the “reader profile” that determines the “significant terms”).

Padwick fails to expressly disclose an electronic message that is altered when received.

Chen teaches a method for identifying and distinguishing words contained within an electronic message (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), comprising the step of:

- altering the electronic message when received (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches “altering the electronic message when received.”);

for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of altering the electronic message when received, for the purpose of calling the user’s attention to the user-specified keywords, as taught in Chen.

*Claim 5:*

Padwick discloses significant terms that are determined based upon a author profile (Padwick discloses this limitation in that Outlook includes a "Rules Wizard" that allows the user to create rules for processing outgoing emails for the "author"; these rules comprise the "author profile" that determines the "significant terms").

Padwick fails to expressly disclose an electronic message that is altered when authored.

Chen teaches a method for identifying and distinguishing words contained within an electronic message (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), comprising the step of:

- altering the electronic message when authored (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify

keywords for both authored emails and received emails. Thus, Chen teaches  
“altering the electronic message when authored.”);  
for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of altering the electronic message when authored, for the purpose of calling the user’s attention to the user-specified keywords, as taught in Chen.

*Claim 6:*

Padwick fails to expressly disclose:

- matched message terms that are identified based upon a reader profile, wherein the electronic message is altered when received.

Chen teaches a method for identifying and distinguishing words contained within an electronic message (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), comprising the step of:

- matched message terms that are identified based upon a reader profile, wherein the electronic message is altered when received (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches “matched message terms that are identified based upon a reader profile” and “altering the electronic message when received.”),

for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of:

- matched message terms that are identified based upon a reader profile, wherein the electronic message is altered when received,

for the purpose of calling the user’s attention to the user-specified keywords, as taught in Chen.

*Claim 7:*

Padwick, in view of Rand, fails to expressly disclose/teach:

- matched message terms that are identified based upon a author profile, wherein the electronic message is altered when authored.

Chen teaches a method for identifying and distinguishing words contained within an electronic message (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), comprising the step of:

- matched message terms that are identified based upon a author profile, wherein the electronic message is altered when authored (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 – Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches “matched message terms that are identified based upon an author profile” and “altering the electronic message when authored.”);



for the purpose of calling the user's attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include the step of:

- matched message terms that are identified based upon a author profile, wherein the electronic message is altered when authored,

for the purpose of calling the user's attention to the user-specified keywords, as taught in Chen.

*Claim 8:*

Padwick discloses *the step of collecting and storing significant terms in the online registry* (see Chapter 22 – Creating and Using Rules; “*Using the Rules Wizard to Create Rules that Manage Incoming Messages*” Pages 1-19 of 19 and “*Creating Rules for Outgoing Messages*” Pages 1-2 of 2 – Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create and save rules for searching incoming or outgoing emails for particular terms. Thus, the rules constitute an “online registry” of “significant terms.”).

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*Claim 9:*

Padwick discloses a *step of collecting and storing [that] comprises a user selecting significant terms* (Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create and save rules for searching incoming or outgoing emails for particular terms; thus, the user “selects significant terms”).

*Claim 10:*

Padwick discloses a *step of collecting and storing [that] comprises importing significant terms* (see Chapter 28 – Creating and Using Rule; “*Managing Rules*” – Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file).

*Claim 11:*

Padwick discloses *significant terms [that] are imported from an address book* (Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file; a “file” includes an address book).

*Claim 12:*

Padwick discloses *significant terms [that] are imported from a database* (Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file; a “file” includes a database).

*Claim 13:*

Padwick discloses *significant terms [that] comprise names of people, product terms or key words in a user's field* (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms, which may include "names of people"; for example, see Figure 28.4).

*Claims 14-16:*

Padwick, in view of Chen, fails to expressly disclose:

- *making alterations to the electronic message comprises making the matched message terms a different color, a different font effect, or a different font type.*

However, selecting a particular color, font effect, or font type for displaying the located search terms was a design choice that was well-known by one of ordinary skill in the art at the time the invention was made. Chen expressly taught "highlighting" the located search terms, but did not disclose the particular color in which the term is highlighted and whether the color, font effect, and/or font type could be changed by the user.

Changing the font effect, font type, and/or color of text in an electronic document was well-known at the time the invention was made by even ordinary computer users. At the time the invention was made, those of ordinary skill in the art (e.g., computer programmers) would have known how to design a search tool so a user could select the particular color, font effect, and/or font type in which the located search term was displayed for the purpose of facilitating aesthetics.

Additionally, Padwick disclosed a Rules Wizard that allowed the user to compose multiple processing rules that are applied to each sent email. Thus, two rules could have been written to locate two different search requests for sent emails and display each located term in different colors, font effects, and/or font types, for the purpose of distinguishing the different search requests within each email.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Chen, to include making alterations to the electronic message comprises making the matched message terms a different color, a different font effect, or a different font type, for the purposes of aesthetics and distinguishing the different search requests within each email.

*Claim 19:*

Padwick discloses *identifying where the alterations to the matched message terms*, taught by Rand, *[is to be] performed according to a user setting* (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms; thus, making the search term “distinct” is performed “according to a user setting”).

*Claim 20:*

Padwick discloses *significant terms [that] are categorized and the user setting is based upon a category of the significant term* (Padwick discloses this limitation in that

the Rules Wizard allows the user to select the search terms and process email messages containing each different search term in a particular way. For example, Outlook can search for all emails that include the term "deadline" and send those emails to a certain folder, or Outlook can search for all emails that include the term "office party" and delete those emails. Thus, the significant terms are "categorized" and the user setting processes emails having the significant terms "based on a category of the significant term.").

*Claim 21:*

Padwick fails to expressly disclose displaying the electronic message if the end of the electronic messages as been reached.

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 – Chen teaches this limitation in that the computer-based document management system allows a user to define criteria comprising key terms, wherein the system identifies documents - including email messages - that satisfy the user-specified criteria and, when displaying those documents to the user, highlights the key terms), *comprising the step of:*

- *displaying the electronic message if the end of the electronic messages as been reached* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 – Chen teaches this limitation in that the computer-based document management

system allows the user to click on any document in a list of documents meeting the user-specified criteria and, upon selection of one of the listed documents by the user, displays the document with the highlighted search term. Thus, the system has scanned the document for the significant term and displays the document "if the end of the electronic messages as been reached."), for the purpose of calling the user's attention to the portion(s) of the displayed document that contain the key terms.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the *step of displaying the electronic message if the end of the electronic messages as been reached* for the purpose of calling the user's attention to the portion(s) of the displayed document that contain the key terms, as taught in Chen.

*Claim 22:*

Padwick fails to expressly disclose querying a user before making alterations to the electronic message.

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 – Chen teaches this limitation in that the computer-based document

management system allows a user to define criteria comprising key terms, wherein the system identifies documents - including email messages - that satisfy the user-specified criteria and, when displaying those documents to the user, highlights the key terms), *comprising the step of:*

- *querying a user before making alterations to the electronic message* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 – Chen teaches this limitation in that the computer-based document management system allows the user to search documents for particular terms and distinctly displays those terms when one of the documents meeting the user-specified criteria is displayed.

Thus, the system “queries the user before making alterations to the electronic message.”),

for the purpose of calling the user’s attention to the portion(s) of the displayed document that contain the key terms.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the *step of querying a user before making alterations to the electronic message*, for the purpose of calling the user’s attention to the portion(s) of the displayed document that contain the key terms, as taught in Chen.

*Claims 23-38 and 41-44:*

These claims merely recite an apparatus for performing the method of Claims 1-16 and 19-22. Padwick discloses and Chen teaches computer systems.

Thus, Claims 23-38 and 41-44 are rejected using the same rationale used in the above rejections for Claims 1-16 and 19-22, respectively.

*Claims 45-60 and 63-66:*

These claims merely recite computer software for performing the method of Claims 1-16 and 19-22. Both Padwick and Chen operate via computer software.

Thus, Claims 45-60 and 63-66 are rejected using the same rationale used in the above rejections for Claims 1-16 and 19-22, respectively.

Claims 17 and 18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Padwick, in view of Chen, and further in view of Larson et al., U.S. Patent No. 5,825,854.

*Claim 17:*

As indicated in the above discussion, Padwick, in view of Chen, discloses/teaches every limitation of Claim 1.

Padwick, in view of Chen, fails to expressly disclose:

- *inserting an object into the electronic message near the matched message term.*



Larson teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 – Larson teaches this limitation in that the telephone access system to audibly highlight a word that is graphically highlighted in an electronic message), *comprising the steps of:*

- *inserting an object into the electronic message near the highlighted message term* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 – Larson teaches this limitation in that the telephone access system inserts an audio file at a highlighted term in an electronic message),  
for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Chen, to include *inserting an object into the electronic message near the matched message term*, for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone, as taught by Larson.

*Claim 18:*

Padwick, in view of Chen, fails to expressly disclose:

- *an object that comprises an image, a sound file, an icon, a link or a video.*

Larson teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 – Larson teaches this limitation in that the telephone access system to audibly highlight a word that is graphically highlighted in an electronic message), *comprising the steps of:*

- *selecting an object that comprises an image, a sound file, an icon, a link or a video* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 – Larson teaches this limitation in that the telephone access system inserts an audio file at a highlighted term in an electronic message),

for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Chen, to include *selecting an object from the group consisting of an image, a sound file, an icon, a link and a video*, for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone, as taught by Larson.

*Claims 39 and 40:*

These claims merely recite an apparatus for performing the method of Claims 17 and 18. Padwick discloses and both Chen and Larson teach computer systems. .

Thus, Claims 39 and 40 are rejected using the same rationale used in the above rejections for Claims 17 and 18, respectively.

*Claims 61 and 62:*

These claims merely recite computer software for performing the method of Claims 17 and 18. Both Padwick, Chen and Larson operate via computer software.

Thus, Claims 61 and 62 are rejected using the same rationale used in the above rejections for Claims 17 and 18, respectively.

***Response to Arguments***

Applicant's arguments filed 02/27/2006 have been fully considered but they are not persuasive.

*The Rejections Based on Padwick and Chen:*

Applicant argues that neither Padwick nor Chen discloses making alterations within the electronic message itself, as recited in the claims. Applicant asserts that the combination of Padwick and Chen merely searches emails for a particular term or phrase and then highlights the display of that particular term or phrase when found, but

without altering the email itself. See *Response* – Page 11, fifth complete paragraph through seventh complete paragraph.

The examiner disagrees.

As indicated in the above rejections, Chen teaches a document management system that highlights user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. Whenever the system detects a user-specified keyword within an email, the system highlights the keyword and stores the email in a user-specified folder. Subsequently, when the user views the email, the keyword is highlighted within emails.

Accordingly, Chen teaches making alterations within the electronic message itself.

### ***Conclusion***

Applicant's amendment necessitated the new grounds of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is 571-272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH  
April 17, 2006



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